REMARKS

Claims 1 through 20 remain pending in the application, and have not been amended.

Claims 1 through 20 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of, variously, Claims 1-23 of Applicant's U.S. Patent No. 5,889,508; Claims 1-5 of Applicant's U.S. Patent No. 5,505,084; Claims 1-10 of Applicant's U.S. Patent No. 6,621,485; and Claims 1-103 of Applicant's U.S. Patent No. 6,724,369 in view of U.S. Patent No. 5,349,263 to Katayama et al..

Applicant respectfully traverses this rejection. Applicant asserts that the combination of the Katayama et al. reference with various ones of Applicant's earlier patents in the manner suggested by the Examiner is not proper.

The Examiner further rejected Claim 1 as being obvious over U.S. Patent No. 5,889,507 to Engle et al in view of Katayama et al.; rejected Claims 2 and 3 as being unpatentable over Engle et al in view of Katayama et al. and further in view of U.S. Patent No. 5,798,754 to Selker et al.; and rejected Claims 4-20 as being unpatentable over Engle et al in view of Katayama et al. and further in view of U.S. Patent No. 5,349,263 to Kline.

Applicant respectfully traverses these rejections as well. Applicant asserts that the combination of the Katayama et al. reference with various ones of Applicant's earlier patents in the manner suggested by the Examiner is not proper. There is no teaching, within the references themselves, to combine the references in the matter suggested by the Examiner.

The Federal Circuit has consistently said that in order for references to be properly combined they must contain some teaching or suggestion of the proposed combination. In *Panduit v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593, 1597 (Fed. Cir. 1987), the Federal Circuit reviewed the District Court's finding that a plastic cable tie was obvious based on prior art under 35 U.S.C. 103. The District Court had concluded that Panduit's cable tie was obvious because its components had separately appeared in prior patents. The Federal Circuit noted that the District Court, "improperly treated all cable ties as

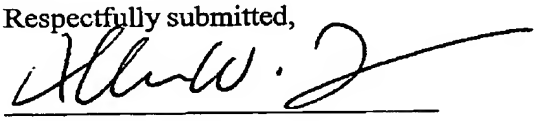
virtually interchangeable ...." *Panduit* at 1600. In reversing the District Court, the Federal Circuit noted that the prior art as a whole must suggest the combination claimed in the application; and "hindsight reconstruction from similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under 35 U.S.C. 103." *Panduit* at 1603, *citing, Akzo N.V. v. International Trade Commission*, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986), and *W.L. Gore & Associates, Inc. v. Garlock*, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 461 (1984).

Here, the rejection is treating all references involving caps as interchangeable and attempting to recreate applicants' invention based on "hindsight reconstruction." Under *Panduit*, such a combination is justified only if the prior art as a whole teaches or suggests the proposed combination, not because of a vague conclusion regarding faster movement of a cursor or non-slip surfaces. Applicant asserts that the references taken as a whole do not supply motivation for the combinations cited by the Examiner, and that such combination is only apparent through the use of hindsight.

For the above mentioned reasons, Applicants respectfully request withdrawal of the rejections of record. In view of the amendments and above remarks, it is believed that the application is in condition for allowance.

Any fees due in connection with this Amendment should be charged to Deposit Account No. 13-0005.

Respectfully submitted,



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